

### REMARKS

#### Interview request

Applicants respectfully request a telephonic interview after the Examiner has reviewed the instant response and amendment. Applicants request the Examiner call Applicants' representative at 858 720 5133.

#### Interview summary - telephonic interview of May 15, 2008

Applicants thank the Examiner for the very helpful and courteous telephonic interview of May 15, 2008, during which issues related to outstanding rejections and the cited art Simmons were discussed for the purpose of placing this application in condition for allowance. Rejections from previous office actions that are now withdrawn were also discussed.

#### Status of the Claims

##### *Pending claims*

Claims 55, 58 to 68, 70 to 76, 79 to 101, 103 to 105, 107 to 113 and 131 are pending in the application. Claims 86 to 100 are withdrawn for not encompassing an elected species, see e.g., pages 4 to 5, paragraph 9 to 11, of the Restriction Requirement/ Species Election Office Communication of March 22, 2006.

##### *Claims added and deleted*

Claims 133 to 138 are added, and claims 55, 58 to 65, 88, 89, 105, 107 to 113 and 131, are deleted, without prejudice or disclaimer, in this amendment; thus, after entry of the instant amendment, claims 66 to 68, 70 to 76, 79 to 87, 90 to 101, 103 to 104 and 133 to 137, will be pending in the application.

##### *Outstanding Rejections*

Claims 55, 58 to 68, 70 to 76, 79 to 85, 87 to 99, 101, 103 to 105, 107 to 113 and 131 are rejected under 35 U.S.C. §102(e), as allegedly anticipated by Simmons et al., U.S. Pat App Pub no. 20050170464. Applicants respectfully traverse all outstanding rejections of the claims.

*Rejoining non-selected species after elected species held allowable*

When the elected species of claims 86 to 100 are held to be allowable, Applicants are entitled to consideration (examination) of additional species; if all species are held to be allowable, a generic claim should be allowed (MPEP §809.02(a); pg 800-53-54, 8<sup>th</sup> Edition, Rev. 6, Aug. 2006).

The instant amended claim 66 is generic to claims 86 to 100, thus addressing any concerns the Office may have regarding their being rejoined after the species are held to be allowable; see e.g., paragraph 3 of section 3, on page 2, the OA.

Support for the Claim Amendments

The specification sets forth an extensive description of the invention in the amended claims. For example, support for claims encompassing polynucleotides encoding antibody heavy chain polypeptides having a prokaryotic secretion signal sequence, e.g., at the amino terminus, can be found inter alia on page 17, lines 10 to 20, of the specification, which is paragraph [0063] of this application's publication U.S. App. Pub. No. 20050048572 ("the '572 publication"). Support for claims encompassing methods providing efficient and high yields of antibodies, e.g., in a suitable host cell, e.g., a prokaryotic cell, can be found, inter alia, in the paragraph spanning pages 4 to 5, and the paragraph of lines 11 to 27, of page 5, of the specification, which is paragraphs [0014] and [0015], of the '572 publication. Support for claims encompassing methods for expressing intact antibodies in various host cells can be found, inter alia, in lines 1 to 25, of page 37, of the specification, which is paragraph [0127], of the '572 publication.

Accordingly, no new matter has been added and the amendment can be properly entered.

Issues under 35 U.S.C. §102(e)

Claims 55, 58 to 68, 70 to 76, 79 to 85, 87 to 99, 101, 103 to 105, 107 to 113 and 131, are rejected under 35 U.S.C. §102(e), as allegedly anticipated by Simmons et al., U.S. Pat App Pub no. 20050170464, filed March 2, 2005, published August 4, 2005 (hereinafter "Simmons").

The Office was concerned that Simmons discussed truncated antibody heavy chains, e.g., scFvs, that do not have heavy chain hinge regions; see the fourth paragraph of page 4, of the OA.

The instant amendment addresses this concern by clarifying that the polynucleotides claimed in this application do not encode scFvs because *inter alia* they encode intact antibodies having a variant antibody heavy chain polypeptide which does not form at least one inter-heavy chain disulfide linkage. Accordingly, because Simmons does not teach these claimed polynucleotides, the rejection under section 102(e) can be properly withdrawn.

CONCLUSION

In view of the foregoing amendment and remarks, Applicants respectfully aver that the Examiner can properly withdraw the rejection of the pending claims under 35 U.S.C. §102(e). In view of the above, claims in this application after entry of the instant amendment are believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 146392005000. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

As noted above, Applicants have requested a telephone conference with the undersigned representative to expedite prosecution of this application. After the Examiner has reviewed the instant response and amendment, please telephone the undersigned at 858 7205133.

Dated: June 26, 2008

Respectfully submitted,

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